

REMARKS

In the Office Action mailed June 19, 2008 (hereinafter, "Office Action"), the Examiner rejected claims 63-76, 98, and 99 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter; rejected claims 1-5, 7, 8, 13, 14, 32-36, 38, 39, 44, 45, 63-67, 70, 75, 76, 94, 96, and 98 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,569,897 to Masuda (hereinafter, "Masuda"); rejected claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Masuda in view of "case law" (Office Action, p. 6); and rejected claims 11, 12, 15-20, 42, 43, 46-51, 73, 74, 77-82, 95, 97, and 99 under 35 U.S.C. § 103(a) as being unpatentable over Masuda in view of Official Notice.

By this response, Applicants hereby cancel claims 11, 12, 42, 43, 73, and 74, without prejudice or disclaimer, and amend claims 1, 32, and 63. No new matter has been added. Claims 21-31, 52-62, and 83-93 were withdrawn by the Examiner. Accordingly, claims 1-10, 13-41, 44-72, and 75-99 are currently pending.

In light of the foregoing amendments and the reasoning presented below, Applicants respectfully traverse the rejection of claims 1-10, 13-20, 32-41, 44-51, 63-72, 75-82, and 94-99 under 35 U.S.C. §§ 101, 102(b), and 103(a), and allowance of the pending claims.

I. Rejection under 35 U.S.C. § 101

The Examiner rejected claims 63-76, 98, and 99 under 35 U.S.C. § 101, alleging that "the claimed invention is directed to non-statutory subject matter." Office Action, p. 2. Specifically, the Examiner stated that "[t]he computer readable medium contains

instructions that could be instructions for a human to execute them rendering them non-statutory unlike the case where the instructions were computer executable.” Id.

While Applicants disagree with the Examiner’s characterization of the claims, to advance prosecution, Applicants have nevertheless amended independent claim 63 to indicate the instructions are executed, for example, “by at least one processor”

Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101, and allowance of claims 63-72, 75-76, 98, and 99.

II. Rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-5, 7, 8, 13, 14, 32-36, 38, 39, 44, 45, 63-67, 70, 75, 76, 94, 96, and 98 under 35 U.S.C. § 102(b) as being anticipated by Masuda. A proper anticipation rejection requires that “each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131. In addition, “[t]he elements must be arranged as required by the claim” Id. (emphasis added). Applicants respectfully submit that Masuda fails to disclose all of the subject matter recited in each of the independent claims 1, 32, and 63, and also fails to disclose the elements as arranged in the claims.

Specifically, Masuda fails to disclose, *inter alia*, “causing the point-of-sale location to prevent the consumer’s purchase of the product if the application is not approved,” as recited in amended independent claim 1, and similarly recited in amended independent claims 32 and 63.

The Examiner acknowledges, on page 7 of the Office Action, that “Masuda does not explicitly teach that the denial of the application will not allow the purchase to be

made” To overcome this deficiency of Masuda, however, the Examiner states that “it is old and well known in the art of credit cards that if a credit card is denied it can not be used to pay for a purchase.” Office Action, p. 7.

Even assuming the Examiner's assertion is correct, a statement to which Applicants do not assent, the Examiner's conclusion is not consistent with the claim recitations. That is, a denial of a credit card for the payment of a purchase is not the same as “causing the point-of-sale location to prevent the consumer's purchase of the product if the application is not approved,” as recited in amended independent claim 1. In the former, the purchaser may continue with the purchase despite the denial of a particular credit card. In the latter, the applicant for the credit is prevented from purchasing the product if the application is not approved..

Accordingly, for at least the above-outlined reasons, Masuda fails to disclose all of the subject matter recited in Applicants' amended independent claim 1. Therefore, the rejection of independent claim 1 under 35 U.S.C. § 102(b) is legally deficient and should be withdrawn, and the claim should be allowed.

Independent claims 32 and 63, although of different scope, include recitations that are similar to those discussed above with respect to independent claim 1. Thus, for at least the same reasons as discussed in connection with independent claim 1, Masuda fails to disclose all of the subject matter recited in Applicants' amended independent claims 32 and 63. Therefore, the rejection of independent claims 32 and 63 under 35 U.S.C. § 102(b) is legally deficient and should be withdrawn, and the claims should be allowed.

Claims 2-5, 7, 8, 13, 14, and 94 depend from amended independent claim 1.
Claims 33-36, 38, 39, 44, 45, and 96 depend from amended independent claim 32.
Claims 64-67, 70, 75, 76, and 98 depend from amended independent claim 63. For at least the same reasons as set forth above in connection with their corresponding amended independent claims, the rejection of claims 2-5, 7, 8, 13, 14, 33-36, 38, 39, 44, 45, 64-67, 70, 75, 76, 94, 96, and 98 under 35 U.S.C. § 102(b) is legally deficient, should be withdrawn, and the claims should be allowed.

III. Rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Masuda in view of “case law” (Office Action, p. 6), and the rejection of claims 11, 12, 15-20, 42, 43, 46-51, 73, 74, 77-82, 95, 97, and 99 under 35 U.S.C. § 103(a) as being unpatentable over Masuda in view of Official Notice because a *prima facie* case of obviousness has not been established. Moreover, Applicants traverse the taking of Official Notice in the Office Action, and respectfully request the Examiner to provide authority to support the Examiner’s position.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III) (internal citations omitted). In addition, when “determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (internal citations omitted) (emphasis in original).

Claims 6, 9, 10, 15-20, and 95 depend from amended independent claim 1. Claims 37, 40, 41, 46-51, and 97 depend from amended independent claim 32. Claims 68, 71, 72, 77-82, and 99 depend from amended independent claim 63. As discussed above, a *prima facie* case of obviousness has not been established because, among other things, Masuda does not teach or suggest the recitations of amended independent claims 1, 32, and 63. For example, Masuda fails to disclose or suggest, *inter alia*, “causing the point-of-sale location to prevent the consumer's purchase of the product if the application is not approved,” as recited in amended independent claim 1, and similarly recited in amended independent claims 32 and 63.

As explained above, the Examiner acknowledges that “Masuda does not explicitly teach that the denial of the application will not allow the purchase to be made” Office Action, p. 7. However, the Examiner appears to take Official Notice, stating that “it is old and well known in the art of credit cards that if a credit card is denied it can not be used to pay for a purchase.” Id.

A general allegation that something may be “well known” is not sufficient to support a taking of Official Notice. “[T]he basis for [the examiner's] reasoning must be

set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” See In re Soli (citation omitted). “The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” M.P.E.P. § 2144.03(B).

The Office Action alleges that “it would be obvious to one having ordinary skill in the art . . . that the denial of a credit application for the card that was going to pay for a purchase would result in preventing the purchase unless some other form of payment was used.” Office Action, p. 7. However, the Office Action fails to provide any reasoning as to why one would have found the claimed invention to have been obvious in light of the teachings of Masuda other than unsupported general allegations. Thus, the Office Action merely provides conclusory statements regarding the prior art, which is not sufficient to establish a *prima facie* case of obviousness.

Moreover, the Examiner’s statement of Official Notice does not address the recitations of amended independent claims 1, 32, and 63, which incorporate the subject matter of now-canceled claims 11, 42, and 73. Nor does the Examiner’s alleged Official Notice cure the defects of Masuda set forth above in connection with claims 1, 32, and 63. For at least these additional reasons the Official Notice does not support the rejection of claims 15-20, 46-51, 77-82, 95, 97, and 99. Consequently, the rejection of claims 15-20, 46-51, 77-82, 95, 97, and 99 in view of Official Notice is legally deficient.

With respect to claims 6, 9, 10, 37, 40, 41, 68, 71, and 72, which respectively depend from amended independent claims 1, 32, and 63, the Examiner has rejected

these claims under 35 U.S.C. § 103(a) as being unpatentable over Masuda in view of “case law.” Office Action, p. 6. Notwithstanding whether the cited case law is applicable to claims 1, 32, and 63, from which claims 6, 9, 10, 37, 40, 41, 68, 71, and 72 depend, the case law does not overcome the failure of Masuda and Official Notice to disclose or suggest, *inter alia*, “causing the point-of-sale location to prevent the consumer's purchase of the product if the application is not approved,” as recited in amended independent claim 1, and similarly recited in amended independent claims 32 and 63.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of claims 6, 9, 10, 15-20, 37, 40, 41, 46-51, 68, 71, 72, 77-82, 95, 97, and 99. Further, to the extent the Examiner is relying on personal knowledge in taking Official Notice, Applicants request that the Examiner provide an Affidavit evidencing such knowledge as factually based or legally competent to support the conclusion.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the cited art. Applicants therefore request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

In addition, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to read 'Joseph E. Palys', is written over a horizontal line.

Dated: December 19, 2008

By: _____
Joseph E. Palys
Reg. No. 46,508